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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/585,925 06/02/00 RAFFERTY

P 2079.1024008

EXAMINER

HM12/0409

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I III, H	
ART UNIT	PAPER NUMBER

1624  
DATE MAILED:

04/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/525 025  
3525

Applicant(s)

Rafferty et al.

Examiner

Hong Liu

Group Art Unit

1624



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-36 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-36 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, 27-drawn to a method of inhibiting protein kinase activity by a compound represented by the formula depicted in claim 1, classified in class 514, subclass 227.5.
  - II. Claims 9 and 34, drawn to a method of treating a hyperproliferative disorder, classified in class 514, subclass 227.5.
  - III. Claims 10, 11, and 35, drawn to a method of affecting angiogenesis, classified in 514, subclass 227.5 .
  - IV. Claims 12, drawn to a method of treating a disease selected from various groups, classified in class 514, subclass 227.5.
  - V. Claim 13, drawn to a method of inhibiting vascular hyperpermeability, classified in class 514, subclass 227.5.
  - VI. Claims 16-26, and 36, drawn to a compound represented by the formula in claim 16 wherein Y is S, SO, or SO<sub>2</sub>, and its compositions, classified in class 544, subclass 58.2.

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VII. Claims 16-26, and 36, drawn to a compound represented by the formula in claim 16 wherein Y is O, and its compositions, classified in class 544, subclass 105.

2. The inventions are distinct, each from the other because of the following reasons:

Groups VI and VII are directed to structurally dissimilar compounds such that the variable core created by varying the definitions of the formula do not belong to a recognized class of chemical compounds in the art, and references anticipating one invention would not render obvious the others, for example, 1,4-thiazine is different from 1,4-oxazine rings. Thus, separate searches in the literature as well as in the U.S. Patent Clarification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One skilled in the art would not consider such diverse structures as functional equivalents of each other. The mere fact that there is a single similarity is not in itself a significant reason to render the whole embodiment obvious.

Inventions VI-VII and I-V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case more than one use exists for compounds of Group I as evidenced by claims 1-15 drawn to a variety of diverse uses. Additionally, the various uses would raise issues of enablement separate from that of the compound claims and would require art-

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recognized evidence that activity relied on its reasonably correlated to in vivo efficacy for the uses claimed.

A telephone call was made to Ms. Theresa Devlin on 03/29/01 to request an oral election to the above restriction requirement, but did not result in an election being made. A written restriction was requested.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Tentative election of a single species with the elected group is further required.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

4. Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the status of


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this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl  
April 2, 2001

  
**Mukund Shah**  
**Supervisory Patent Examiner**  
**Art Unit 1624**